

REMARKS

By this amendment, claims 20-22, 31-32, and 42 have been amended. Claims 20-22, 24-26, 31-33, 36, 42, and 47-55 are pending in the application. Applicants reserve the right to pursue the original claims and other claims in this and other applications.

On May 16, 2007, Applicants' representative conducted a telephonic interview with the Examiner. Amendments to the independent claims were discussed in relationship to prior art. The discussed material was incorporated into this Amendment, and discussed below.

Claims 20 and 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Matheny et al. (US 6,766,524) in view of Kamada et al. (US 7,039,928), and further in view of Ismail et al. (US 6,614,987). This rejection is respectfully traversed. In order to establish a *prima facie* case of obviousness "the prior art reference (or references when combined) must teach or suggest all the claim limitations." M.P.E.P. §2142. None of Matheny et al., Kamada et al., or Ismail et al., even when considered in combination, teaches or suggests all limitations of claim 20.

Kamada et al. teaches that when an individual audience selects a program continuously for a constant time period or more, it is determined that the individual audience watched the selected program (FIG. 6, steps S607, S609). In contrast, according to claim 20, the "individual interest information" comprises category information generated not based on the selected program itself, but automatically generated based on the category of the program watched by an individual audience by using the television program category table (media program category storage portion) having the television programs classified into categories in advance, and the individual audience result information (Specification, Fig. 3) about which viewer had watched which television program/programs (*see* Specification, page 14, ln. 9 to 13, etc.).

Nor does Matheny et al. remedy the deficiency of Kamada et al. Matheny et al. teaches that “[V]iewers must provide some feedback to indicate that they watched the commercial.... [S]et-top box 245 presents the viewer with a test question 265.... [V]iewers who watch the commercial are able to answer the question correctly.... Entering the correct answer in field 270 entitles a viewer to the offered reward.” Col. 3, ln. 17-29 (emphasis added). Applicants respectfully submit that Matheny et al. does not disclose, teach, or suggest an individual interest information portion configured to automatically generate individual interest information comprising at least one program category based on the individual audience result information, as recited in claim 20.

Nor does Ismail et al. remedy the deficiencies of Kamada et al. and Matheny et al. Applicants respectfully submit that Ismail et al. teaches a preference database representing attribute information of programs watched by a user (individual audience) which is information necessary for investigating favorite programs of the individual audience so as to automatically select the favorite programs of the individual audience. In contrast, as explained above, the present invention is intended to collect the individual interest information as the marketing information. Ismail et al. does not disclose, teach, or suggest an individual interest information portion configured to automatically generate individual interest information comprising at least one program category based on the individual audience result information, as recited in claim 20.

Since Matheny et al., Kamada et al., and Ismail et al. do not teach or suggest all of the limitations of claim 20, claim 20 and dependent claim 48 are not obvious over the cited combination. Applicants respectfully request that the 35 U.S.C. § 103(a) rejection of claims 20 and 48 be withdrawn and the claims allowed.

Claims 31-33, 36, 47, and 50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Arai et al. (US 6,486,920) in view of Saitoh (US 5,444,499), further in view of Ismail et al., and still further in view of Matheny et al. This rejection is respectfully traversed. None of Arai et al., Saitoh, Ismail et al., or Matheny et al., even when considered in combination, teaches or suggests all limitations of independent claims 31-32.

To the contrary, Saitoh teaches recording which channel is watched at which day and which time. In contrast, the invention of claims 31-32 does not perform such classification, but classifies television programs watched by an individual audience into categories by using the television program category table. That is, the claimed invention is not intended to know which program is watched by an individual audience, but to grasp in which information the individual audience is interested, whereby it becomes possible to generate "the individual interest information" of the individual audience thereby to collect "marketing information."

Applicants respectfully submit that Saitoh does not disclose, teach, or suggest individual interest information portion configured to automatically generate individual interest information comprising at least one program category based on the individual audience result information, as recited in claims 31-32.

Nor does Arai et al. remedy the deficiency of Saitoh. Arai et al. teaches "producing and displaying a 'my channel' consisting of programs fulfilling the search conditions (e.g., fee) given from the user." Col. 8, ln. 48-49 (emphasis added). Applicants respectfully submit that Arai et al. does not disclose, teach, or suggest automatically generating the individual interest information comprising at least one program category based on the individual audience result information, as recited in claims 31-32.

Nor, as discussed above, do Ismail et al. or Matheny et al. teach the limitations of claims 31-32.

Since Arai et al., Saitoh, Ismail et al., and Matheny et al., do not teach or suggest all of the limitations of claims 31-32, claims 31-32 are not obvious over the cited references. Claims 33, 36, 47, and 50 depend from claim 32, and are patentable at least for the reasons mentioned above, and on their own merits.

In addition, the "requisite prior art suggestion to combine becomes less plausible when the necessary elements can only be found in a large number of references. . . ." *Eli Lilly & Co. v. Teva Pharms. USA, Inc.*, 2004 U.S. Dist. LEXIS 14724 at *104; 2 *Chisum on Patents* § 5.04[1][e][vi]. In the present application, the lack of identifiable objective motivation to combine the four references, in addition to the sheer number of disparate references applied by the Office Action, is sufficient to overcome the asserted obviousness arguments. The Office Action does not give a motivation for combining each of the four references with each of the other references. The Office Action has not applied the proper test for obviousness; accordingly, the Office Action fails to make a *prima facie* case of obviousness.

Applicants respectfully request that the 35 U.S.C. § 103(a) rejection of claims 31-33 and 36 be withdrawn and the claims allowed.

Claims 21-22, 24-26, 42, 49, and 51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Arai et al. in view of Matheny et al., further in view of Kamada et al., and still further in view of Ismail et al.. This rejection is respectfully traversed. None of Arai et al., Matheny et al., Kamada et al., or Ismail et al., even when considered in combination, teaches or suggests all limitations of independent claims 21-22 and 42. Claims 21-22 and 42 recite limitations similar to claims 20 and 31-32. As discussed

above, Arai et al., Matheny et al., Kamada et al., and Ismail et al. do not disclose, teach, or suggest automatically generating the individual interest information comprising at least one program category based on the individual audience result information. Since Arai et al., Matheny et al., Kamada et al., and Ismail et al. do not teach or suggest all of the limitations of claims 21-22 and 42, claims 21-22 and 42 are not obvious over the cited references. Claims 24-26, 49, and 51 depend, respectively, from claims 21-22 and 42, and are patentable at least for the reasons mentioned above, and on their own merits.

In addition, the lack of identifiable objective motivation to combine the four references, in addition to the sheer number of disparate references applied by the Office Action, is sufficient to overcome the asserted obviousness arguments. The Office Action does not give a motivation for combining each of the four references with each of the other references. The Office Action has not applied the proper test for obviousness; accordingly, the Office Action fails to make a *prima facie* case of obviousness.

Applicants respectfully request that the 35 U.S.C. § 103(a) rejection of claims 21-22, 24-26, 42, 49, and 51 be withdrawn and the claims allowed.

Claim 52 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Arai et al. in view of Saitoh, further in view of Ismail et al, and still further in view of Matheny et al. This rejection is respectfully traversed. Claim 52 depends from claim 31 and is patentable at least for the reasons mentioned above, and on its own merits. In addition, the lack of identifiable objective motivation to combine the four references, in addition to the sheer number of disparate references applied by the Office Action, is sufficient to overcome the asserted obviousness arguments. The Office Action does not give a motivation for combining each of the four references with each of the other references. The Office Action has not applied the proper test for obviousness;

accordingly, the Office Action fails to make a *prima facie* case of obviousness.

Applicants respectfully request that the 35 U.S.C. § 103(a) rejection of claim 52 be withdrawn and the claim allowed.

Claim 53 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Matheny et al. in view of Kamada et al., and further in view of Ismail et al. This rejection is respectfully traversed. Claim 53 depends from claim 20 and is patentable at least for the reasons mentioned above, and on its own merits. Applicants respectfully request that the 35 U.S.C. § 103(a) rejection of claim 53 be withdrawn and the claim allowed.

Claims 54-55 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Arai et al. in view of Matheny et al., further in view of Kamada et al., and still further in view of Ismail et al. This rejection is respectfully traversed. Claims 54-55 depend, respectively, from claims 21-22 and are patentable at least for the reasons mentioned above, and on their own merits.

In addition, the lack of identifiable objective motivation to combine the four references, in addition to the sheer number of disparate references applied by the Office Action, is sufficient to overcome the asserted obviousness arguments. The Office Action does not give a motivation for combining each of the four references with each of the other references. The Office Action has not applied the proper test for obviousness; accordingly, the Office Action fails to make a *prima facie* case of obviousness. Applicants respectfully request that the 35 U.S.C. § 103(a) rejection of claims 54-55 be withdrawn and the claims allowed.

In view of the above, Applicants believe the pending application is in condition for allowance.

Dated: June 19, 2007

Respectfully submitted,

By 

Mark J. Thronson

Registration No.: 33,082

Rachael Lea Leventhal

Registration No.: 54,266

DICKSTEIN SHAPIRO LLP

1825 Eye Street, NW

Washington, DC 20006-5403

(202) 420-2200

Attorneys for Applicants